

---

---

In the United States  
**Circuit Court of Appeals**  
For the Ninth Circuit

---

SAM SCHNITZER, HARRY J. WOLF, ROSE  
SCHNITZER and JENNIE WOLF individu-  
ally, and as a co-partnership doing business  
under the name and style of ALASKA  
JUNK CO.,

*Appellants,*

vs.

CALIFORNIA CORRUGATED CULVERT  
CO., a corporation, and LEO T. CROWLEY,  
Alien Property Custodian of the United  
States,

*Appellees.*

---

**APPELLANTS' REPLY BRIEF**

---

Upon Appeal from the District Court of the United  
States for the District of Oregon.

---

J. S. MIDDLETON,  
1035 Pacific Building,  
Portland, Oregon,  
*Attorney for Appellants.*

WILLIAM S. GRAHAM,  
111 Sutter Street,  
San Francisco, California,

T. J. GEISLER,

L. R. GEISLER,

Platt Building,  
Portland, Oregon,

CARL DONAUGH, United States District Attorney  
for the District of Oregon,

J. H. HAZLETT, his Deputy,  
United States Court Building,  
Portland, Oregon,

*Attorneys for Appellees.*

FILED

AUG 1 1943

PAUL P. O'BRIEN

CLERK



## INDEX

	Page
Errata . . . . .	1
The Basis of Appellees' Position . . . . .	1
The Invention Described in Lanninger Patent . . . . .	4
The Quality of Invention . . . . .	4
The Disclosure and Claim in Suit . . . . .	6
Claim 3 is a Valid Combination . . . . .	7
Lanninger's New Use of Flexible Joints . . . . .	7
Cooperation of Elements of the Combination . . . . .	8
Simplicity Does Not Negative Invention . . . . .	8
Commercial Success . . . . .	9
Plaintiffs' Commercial Device of Exhibit 17 is Made According to the Lanninger Disclosure . . . . .	10
Prior Art Neither Negatives Validity nor Narrows Claim 3 . . . . .	11
Specification I—Flexible Hose Couplings Are Non-analogous Art . . . . .	13
Lanninger Patent Entitled to Liberal Construc- tion . . . . .	15
Specification III—File Wrapper of Lanninger Patent . . . . .	16
Infringement . . . . .	16
Defendants' Claim That Their Devices are Made Under Pierce Patent No. 1,945,293 . . . . .	19
Matters Not Discussed . . . . .	19
Claim Language Not Ignored by Trial Court . . . . .	20

## TABLE OF CASES

	Page
Bingham Pump Company, Inc. v. Leonard L. Edwards 118 Fed. 2nd 338, 340.....	14
Cimiotti Unhairing Co. v. American Fur Refining Co., 198 U.S. 399, 414, 49 L. Ed. 1100.....	11, 19
Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U.S. 45, 67 L. Ed. 523, 534.....	8
Electric Signal v. Hall Co., 114 U.S. 87, 96, 29 L. Ed. 96 .....	11, 19
Elvin Mechanical Stoker Co. v. Locomotive Stoker Co., 286 Fed. 309, 311 (C.C.A. 3, 1923).....	9, 15
Ford Motor Co. vs. Parks & Bohne, 21 Fed. 2nd 943, (C.C.A. 8, 1927) .....	15
Fulton Co. v. Powers Regulator Co., 263 Fed. 578-580 (C.C.A. 2, 1929) .....	3
H. K. Regar & Sons, Inc. v. Scott & Williams, Inc., 63 Fed. 2d 229, 231.....	7
Payne Furnace & Supply Co., Inc. v. Williams-Wallace Co., 117 Fed. 2d 823, 825 (C.C.A. 9, 1941) .....	6, 8
Pyrene Mfg. Co. v. Boyce, 292 Fed. 480, 481.....	4
Richmond Screw Anchor Co. v. U. S., 275 U.S. 331, 72 L. Ed. 303 .....	5, 6, 15
Samuel B. Smith v. E. H. Snow, et al., 294 U.S. 1, 20, 79 L. Ed. 721, 732.....	6
Sanitary Refrigerator Co. v. Winters, 280 U.S. 30, 41-43, 74 L. Ed. 147.....	11
United States v. Dubilier Condenser Corp., 289 U. S. 178, 77 L. Ed. 1114, 1119.....	5
Wire Tie Mach. Co. v. Pacific Box Corp., 102 Fed. (2d) 543, 556 (C.C.A. 9, 1939).....	15

## REFERENCE WORKS

Webster's Unabridged Dictionary (G. & C. Merriam, 1918) .....	15
---	----

In the United States  
**Circuit Court of Appeals**  
For the Ninth Circuit

---

SAM SCHNITZER, HARRY J. WOLF, ROSE  
SCHNITZER and JENNIE WOLF individu-  
ally, and as a co-partnership doing business  
under the name and style of ALASKA  
JUNK CO.,

*Appellants,*

vs.

CALIFORNIA CORRUGATED CULVERT  
CO., a corporation, and LEO T. CROWLEY,  
Alien Property Custodian of the United  
States,

*Appellees.*

---

**APPELLANTS' REPLY BRIEF**

---

Upon Appeal from the District Court of the United  
States for the District of Oregon.

---



## ERRATA

Before proceeding with the reply brief appellants call to the attention of the Court two errors appearing in the appellants' original printed brief.

At page 29, in the incomplete paragraph at the top of the page, Exhibit 17 is twice referred to. The first reference is correct, but the second reference should be to Exhibit 70 instead of to Exhibit 17.

At page 47, the third from the last line in the second full paragraph on the page commences with the word "pellees". The correct reference is "pellants". The word "appellants" in the next following line should be "appellees'.

### THE BASIS OF APPELLEES' POSITION

Turning now to an analysis of the matters discussed in the appellees' answering brief, there is first called to the attention of the Court the following, quoted from pages 28 and 29:

"Now, of course, plaintiffs do not contend that Laninger was the first to recognize the problem of conveying water in pipes over irregular ground, since that has been done for centuries; nor of the bell and spigot joint, nor of a hinged connection of pipes, nor of a flanged packing; nor of a means to secure pipe together. \* \* \* He knew, as had been known for centuries, that water required pressure to flow upwardly against the force of gravity and that irregular ground had upward inclines as well as downward inclines. \* \* \* And he recognized that he must overcome that pressure and prevent the pipes from blowing apart,



without destroying the other factors for solving his problem.”

Interspersed with the foregoing, are certain statements of what Lanninger did in the premises; and the summation of the statement is (page 29 appellees' brief) :

“It was this new idea of possibilities, this new conception of utilizing irregular ground under portable artificial irrigation and the application of the remedy, for which Lanninger, like Eibel, was entitled to be rewarded in his patent.”

The attention of the Court is particularly directed to the above quoted language which discloses three outstanding facts, all to be borne in mind at all times in an analysis of appellees' answering brief. These facts are:

1. Appellees concede that all of the component parts of the combination disclosed in claim 3 of the patent in suit are old; and

2. The problem to be considered by the patentee was old; and

3. The appellees seek as a part of their attempt to sustain the validity of claim 3 of the patent in suit, to patent the use or result of the combination in addition to and as a part of the combination itself, without, in so doing, being restricted to the use of the elements named in the combination claim of the patent in suit.

This, of course, they may not do, for use and result are not patentable. The protection of the patent resides in the claims alone, and is co-extensive therewith.



“Strictly speaking infringement of a patent is an erroneous phrase; what is infringed is a claim, which is the definition of the invention and it is the claim which is the cause of action. One may appropriate many of the ideas or concepts suggested by specification or drawing, but it is the claim that measures both the patented invention and the infringement thereof. This rule obtains whether the patent be properly spoken of as great, or small, primary or secondary.” *Fulton Co. v. Powers Regulator Co.*, 263 Fed. 578-580 C.C.A. 2, 1920.

“A patentee may describe something that he does not claim or claim that which he has not described; his grant of privilege is construed to cover only that which is both described and claimed no matter how broad the claim-language may be. \* \* \* so that a patent (i e., a claim) can never be given a construction broader than its terms in order to cover something which might have been claimed but was not.” *Fulton Co. vs. Powers Regulator Co.*, 263 Fed. 578-580, (C.C.A. 2—1920)

It will be observed that the third of the above stated elements is made the subject matter of the appellees’ “*Further Statement of the Case*” appearing on pages 3 and 4 of appellees’ brief; and so, at the outset, we find the appellees endeavoring to interject the issues of use and function as elements of the patented combination; and such issues are, of course, wholly improper. This interjection appears at various places in appellees’ brief, but space will forbid repeated reference to the various instances as they occur.

## THE INVENTION DESCRIBED IN LANNINGER PATENT

Under this heading the appellees discuss this subject. They, however, ignore the quoted matter on page 5 pertaining to the "very strong vertical flange" and "the flange of the packing is held in a recess", exact details of the patent application unfavorable to appellees, and on page 6 endeavor to minimize the "clamping" feature of Lanninger's construction as it pertains to the retention of his flanged packing, terming the "clamping" feature an alternative or optional form only, whereas in fact, in his first application to the patent office (page numbered 1, Exhibit 45) Lanninger termed the "clamping" feature one of the "salient" features of his invention and, in five of the six claims of the patent, the clamping of the flange is provided for. Appellees' attempted analysis of the patentee's "invention" reaches a result opposite to the exact language of the patentee's patent application and five of the six claims of his patent.

## THE QUALITY OF INVENTION

Here appellees cite *Pyrene Mfg. Co. v. Boyce*, 292 Fed. 480, 481. The definition of "invention" laid down by the Court in this case must be read in the light of the facts disclosed by the opinion; for those facts the Court had in mind in laying down its definition. And the facts were that the restricted and selected location of the device in the radiator was the cause and reason for its success as contrasted with the restricted form of the Lanninger packing here in issue which

negatived the commercial success of the Lanninger "invention". Under the facts here present, neither the novelty nor utility mentioned in the Court's definition of invention in the cited case is present; and the definition is therefore not here applicable.

In *U. S. v. Dubilier Condenser Corp.*, 289 U.S. 178, 77 L. Ed. 1114, 1119, the question before the Court was not patent infringement, but an attempt to secure ownership in the government as beneficiary in trust, of certain patents. Definition by the Court of "invention" was, therefore, incidental only to determination of the actual issues. And the definition quoted on page 8 of appellees' brief must be read in the light of language immediately preceding the quotation, as follows:

"The reluctance of courts \* \* \* is due to a recognition of the peculiar nature of the act of invention which consists neither in finding out the laws of nature nor in fruitful research; as to the operation of natural laws but in discovering how those laws may be utilized or applied for some beneficial purpose by a process, a device or a machine."

The Court did not endeavor to say how much of its definition of "invention" is patentable invention.

Appellees quote from *Richmond Screw Anchor Co. v. U. S.*, 275 U.S. 331, 72 L. Ed. 303. We also quote from the opinion in that case. Appellees claim that claim 3 of the patent in suit is to be construed to include packings other than the flanged packing disclosed by the patentee.

"The patent was a combination patent and in view of the prior art was limited to the exact terms of the claims which made it quite narrow as its

course through the patent office clearly demonstrated.”

Further, it may be observed that in this case the invention in the form described by the patentee received general acceptance in use as distinguished from the case at bar wherein the patentee's disclosures have never been reduced to practice commercially.

### THE DISCLOSURE AND CLAIM IN SUIT

The language of the Court in *Samuel B. Smith v. E. H. Snow, et al.*, 294 U.S. 1, 20, 79 L. Ed. 721, 732, is appellants' conception of the law, particularly with reference to the quotation

“\* \* \* since the claims of the patent not its specifications measure the invention”

when it is remembered that this Court has said in *Payne Furnace & Supply Co., Inc. v. Williams-Wallace Co.*, 117 Fed. (2d) 823, 825 (C.C.A. 9, 1941)

“The claims of a patent are to be understood and interpreted in the light of its specifications” (Citing authorities),

and when one remembers also the language of the United States Supreme Court in *Richmond Screw Anchor Co. v. U. S.*, supra. It becomes obvious that the disclosure and claim in suit cannot be construed as infringed by the accused devices for the reason that the latter do not employ one of the essential elements of the combination of the claim in suit, the flanged packing.



### CLAIM 3 IS A VALID COMBINATION

This matter has already been discussed in Specification II of appellants' brief.

### LANNINGER'S NEW USE OF FLEXIBLE JOINTS

Appellees' discussion here again is predicated upon use as an element of patentability. They ignore the obvious fact that the structure of Berry (Exhibit 36, page 413, et seq. Tr.) could as well be used for the same purpose, for which indeed Berry's specifications (lines 11 to 26, inclusive, page 417 Tr.) expressly fit it. Appellees discuss the "releasably secured flexibility" of the Lanninger device. Berry also shows a coupling releasably secured, perhaps not so readily as Lanninger's, though that is matter of degree; but claim 3 in suit says nothing about releasably securing means and does speak of *hingedly* securing means which Berry discloses also. Following now the further language of the Court in *H. K. Regar & Sons, Inc. v. Scott & Williams, Inc.*, 63 Fed. (2d) 229, 231, we find

"But a new use of an old thing or an old process, quite unchanged, can under no circumstances be patentable; not because it may not take as much inventiveness to discover it as though some trivial change were necessary but because the statute allows patents only for a new 'art, machine, manufacture or composition of matter' (Section 31, Title 35, U. S. Code—35 U.S.C.A. Section 31) The test is objective; mere discovery will not do. In the case at bar it is indeed hard to find even a new use; perhaps it would be more accurate to speak of a use for what had theretofore been thought useless \* \* \*."

The same thing may be said of the use of the flexible pipe coupler for irrigation although, unfortunately, not of the Lanninger pipe coupler because that has never been used.

## COOPERATION OF ELEMENTS OF COMBINATION

It is stated (page 16 appellees' brief) that the appellants "complete the combination of the claim by attaching the respective hook and latching lock" mentioned, which statement is, of course, incorrect for the reason that the appellants do not use the flanged packing. In *Payne Furnace & Supply Co. v. Williams-Wallace Co.*, 117 Fed. (2d) 823, cited in this discussion, aggregation was not urged, on the face of the Court's opinion.

## SIMPLICITY DOES NOT NEGATIVE INVENTION

In this discussion it is stated

"A part of Lanninger's inventive concept lay in the fact that he recognized the existence of a problem  
\* \* \*"

As pointed out at the beginning of this brief, the appellees expressly admit that the problem had been recognized generally for centuries. The conclusion arrived at by the Court in *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 67 L. Ed. 523, 534, is not here in point, for the reason that Eibel solved his problem and his solution was accepted com-



mercially, whereas Lanninger's solution was not so accepted. The other cases cited do not here apply for the same reason; and the combination of claim 3 of the patent in suit involving as one of its integral parts and "salient" features the flanged packing has not been made at all for commercial use.

### COMMERCIAL SUCCESS

Under this heading, appellees admit departure from the "exact form" of the Lanninger drawings in order to facilitate economical manufacture in quantity of devices like Exhibit 17 and "so that the device may be galvanized against rusting, and the hot galvanizing drained from the sleeve and not fill the interior groove." All four reasons are excellent reasons why the Lanninger device was not a commercial success; and they are also reasons why Lanninger's "flange" packing is absent from Exhibit 17 and the commercial devices corresponding thereto; and they are reasons why its mode of operation is not the same as Exhibit 70, though this sameness is stated on page 30, appellees' brief to be the fact. One must revert once more to the language of the Court in *Elvin Mechanical Stoker Co. v. Locomotive Stoker Co.*, 286 Fed. 309, 311, C.C.A. 3, 1923, cited in appellants' original brief herein:

"declining to construe his claims in any broad way to cover other devices whose commercial success in the art lies, *not in the fact that they adopted his disclosures but that they departed from them.*"

**PLAINTIFFS' COMMERCIAL DEVICE OF EXHIBIT 17 IS MADE ACCORDING TO THE LANNINGER DISCLOSURE**

Here we have an attempt by appellees to play upon words and to make the definition in Knight's Mechanical Dictionary (Exhibit 96) cover anything and everything having any sort of a rim and make it a "flange" packing, despite the fact that in his patent application (Exhibit 45) Lanninger termed his "flange" packing both by that name and its alternate trade name of a "hat" packing, fully identifying it by both of its trade names and distinguishing it from the "U" packing of Anderson, saying:

"(Letter of February 12, 1929, Exhibit 45) Furthermore he does not show a packing having a flange clamped in the sleeve and the free portion extending into the sleeve and frictionally engaging the unthreaded end of the pipe \* \* \* claims 12 and 13 are generic \* \* \* for while claim 13 defines the sleeve as being formed with the groove frictionally retaining the flange of the packing, claim 12 defines the sleeve as including means for clamping the flange in the sleeve \* \* \*"

and also identifying it exactly in all of the patent drawings.

Assault is made upon the testimony of the witness McDougall. Again a play upon words. The witness did speak of metallic flanges and he also correctly adhered to the trade and recognized name of the "flange" packing. At page 33, having reached the conclusion that Mr. McDougall bears out the appellees in their contention, the appellees next state

“but it is not its name but what it does which is the determining factor.”

Of course, if this were true, the appellees' cause would be enhanced. But the case cited, Sanitary Refrigerator Co. v. Winters, 280 U.S. 30, 41-43, 74 L. Ed. 147, lays down another requirement which is that the two devices “do the same work in *substantially the same way*”. See also, Electric Signal v. Hall Co., 114 U.S. 87, 96, 29 L. Ed. 96, and Cimiotti Unhairing Co. v. American Fur Refining Co., 198 U.S. 399, 414, 49 L. Ed. 1100, and quotations therefrom, page 19 of this brief. As fully developed in the discussions at pages 38 and 39, appellants' brief herein, Lanninger's “flange” packing and the “U” packing of the accused devices do not operate in the same way.

The testimony of Mr. Finkbeiner is attacked (pages 32 and 33 appellees' brief) on the theory that he recognizes “inside flanges” and “outside flanges”. He does recognize what counsel for the appellees is talking about in this connection (page 275, Tr.) but on page 276 it appears that the witness is talking about Exhibit 6, the Lanninger gasket, which does have a flange; and apparently this discussion goes back at least to the first answer on page 276.

### **PRIOR ART NEITHER NEGATIVES VALIDITY NOR NARROWS CLAIM 3**

The Jones patent, here referred to, does not mention flexibility; neither does it mention rigidity and, of course, Jones was entitled to its protection in all of

its manifestations, flexible or rigid. Obviously, if flexibility were desired, all that is required is a loose fit of the parts, to provide in the same way the same flexibility that Lanninger accomplishes. If made with loose fitting parts to permit flexibility, the means for hingedly securing the portions together is present. Appellees point out that there is no need for flexibility in the joint because the flexibility is present in the hose. It remains only, on this point, to consider the couplings of air hoses between all railroad cars, old and familiar to all of us, wherein the coupling is expressly made to function and does function to permit a free movement of the coupling joint in coupling up in use, thereby relieving wear on the hose. Perhaps not so well known, but equally old, are the ball and socket joints used on large wire wound hoses for the unwatering of ships in salvage work, again where it is preferred that the joint provide flexibility to avoid wear on the hose. Appellees' contention of non-analogy fails.

In the discussion of the Berry patent (pages 36 and 37, appellees' brief) the point is made that the joints are "permanently and mechanically connected". The Berry patent (Exhibit 36) discloses flexibility of the joint and locking means, hinged in character. The element of permanence of connection of the locking means is not discussed as it is not discussed in claim 3 of the patent in suit. No limitation on the "permanence" of the locking means is laid down in either case in the claim; and both are of course, mechanically connected. It is endeavored to distinguish between the



“clamped” flange of the packing in the Berry patent and “frictional retention”. Yet further down on page 37 it is stated, and correctly, that a clamp is one form of frictional holding. And it is stated that at pages 30 and 32 of appellants’ brief a distinction between the two means is drawn. We look in vain for such a distinction in appellants’ brief at the pages mentioned or elsewhere other than as Lanninger, in the quoted portions of the file wrapper and contents (pages 32, 33) and in the claims of his patent made such a distinction and as that distinction has been later commented upon, in development of Lanninger’s actual claimed ideas. The distinction is the distinction of Lanninger, not of these appellants, though comment by these appellants on Lanninger’s views and the views of the appellees has been necessary.

Appellees’ discussion of the prior art patents other than Berry and Jones receives no comment here, other than that the other prior art patents show generally utilization in pipe connections of one type or another of the various component parts of the Lanninger structure. Nothing is claimed for these patents, other than Berry and Jones, as anticipation.

### **SPECIFICATION I—FLEXIBLE HOSE COUPLINGS ARE NON-ANALOGOUS ART**

This matter has been briefly covered under the heading “Prior Art Neither Negatives Validity nor Narrows Claim 3”, *supra*. It being shown that the coupling of hoses by flexible joints is on occasion a

necessary and practical expedient, it is believed that the analogy is established. However, to consider the matter clearly, and to dispose of any question arising from the language of the cited authorities:

Assume that prior to the application for the Lanninger patent, a patent had issued for the coupling of hoses, disclosing in combination, in the words of claim 3 of the patent, in suit, except for the substitution of the word "hose" for the word "pipe" wherever the latter appears in the claim, the identical structure claimed in claim 3 of the patent in suit, but with specifications explaining and extolling the virtues of the invention for use in connection with hoses to prevent the wear, straining, and breaking thereof adjacent to their ends. Can it be for one moment assumed that in the face of such a structure, and such claims, patent would have issued to Lanninger? To envision such a result, one must also assume the patenting of use or function. This Court has ruled in *Bingham Pump Company vs. Leonard L. Edwards*, 118 Fed. 2d, 338, 340:

"It is clear that Appel did not conceive of the use of his device as appellee conceives his. However, if Appel's device can be used for the same purpose, it is immaterial whether he conceived of that use. \* \* \* Therefore, the fact that Appel did not know that his device could be used for the same purpose as appellee's device does not preclude the defense of anticipation."

It is obvious that most hose couplings could be used on pipe, and vice versa. Couplings made to the disclosures of the claim in suit might quite evidently be used, if desired, on hose. It is reiterated that the arts of coupling pipe and hose are analogous.



From Webster's Unabridged Dictionary (G. & C. Merriam, 1918) the following definitions are quoted:

Conduit—An artificial channel, as a pipe—for conveying water or a fluid.

Hose—A flexible pipe, as of leather or India rubber for conveying fluids, especially water.

Pipe—Any long tube or hollow body, of wood, metal, earthenware, or the like as to conduct water, steam, etc.

Tube—A hollow cylinder of any material.

In *Ford Motor Co. v. Parks & Bohne*, 21 Fed. 2nd 943 (C.C.A. 8, 1927), the Court says:

“The application of an old device to a new use is not in itself an invention or capable of protection by a patent \* \* \* It is only when the new use is so reconдите and remote from that to which the old device has been applied, or for which it was conceived, that its application to the new use would not occur to the mind of the ordinary mechanic, skilled in the art, seeking to devise means to perform the desired function, with the old machine or combination present before him, that his conception rises to the dignity of invention.”

## LANNINGER PATENT ENTITLED TO LIBERAL CONSTRUCTION

The law on this point, stated in *Elvin Mechanical Stoker Co. v. Locomotive Stoker Co.*, 283 Fed. 309 (311) C.C.A. 3, 1923, quoted at pages 29 and 30, appellants' brief herein, also laid down by this Court in *Wire Tie Mach. Co. v. Pacific Box Corp.*, 102 Fed. (2d) 543, 556, C.C.A. 9, 1939, and as stated in the decisions quoted and cited under Specification III of appellants' brief, and as succinctly stated in *Richmond Screw Anchor Co. v. U. S.*, 275 U.S. 331, 72 L. Ed. 303,

“The patent was a combination patent, and in view of the prior art was limited to the exact terms of the claims which made it quite narrow as its course through the patent office clearly demonstrated”

is settled. The decisions cited by appellees do not change the above enunciated rules.

### **SPECIFICATION III—FILE WRAPPER OF LANNINGER PATENT**

This matter has been discussed, pages 30 and subsequent of appellants' brief. Lack of space and desire to avoid repetition forbids a re-examination of the subject, though the fact is called to the attention of the Court that at the top of page 52, Appellees' Brief, it is endeavored, because of a comma, to change the meaning of the patentee's language to mean that which he did not mean, and further down on the page the mechanical clamp is minimized whereas it seems to have been Lanninger's first and primary conception. This matter will be left to the Court's construction of the patentee's English in the light of the discussion originally presented by appellants commencing at page 30 of their brief, and without further comment.

### **INFRINGEMENT**

At page 58, appellees' brief, the testimony of the witness Finkbeiner is again assailed. Again, a word is seized upon to change or confuse a meaning. Continuing from page 276 to 290, Tr., counsel for the appellants endeavors to induce the same witness to concede

that all packings, in substance, are flange packings; and the witness, under a searching examination, makes his position quite plain. If his whole testimony be read, there will be found no variation from his fundamental and correct assertion of the facts.

On page 59, Mr. Pierce is quoted at pages 342-349, Tr. as establishing that there is a tight fit between the packing in the accused device and the internal groove in the sleeve. A reading of the testimony of Mr. Pierce will disclose that it is not necessary that the packing member of the accused devices fit tightly in the groove (page 342 Tr.); that the packings are sometimes tight and sometimes loose (pages 342 and 343 Tr.); and generally, from the remainder of his testimony, that they work as well in either case. This statement in appellees' brief is therefore incorrect. And on page 60, it is urged that Mr. Finkbeiner's testimony to the effect that the packing of the accused devices is not frictionally held in the groove, is incorrect. It is sought, farther on on this page, to make Finkbeiner's testimony show that the retention of the packing of the accused devices in the groove of the sleeve by their size and shape is synonymous with Lanninger's "frictional retention". On this point, it will be recalled that the appellees' witness Vale, speaking of the retention of the Lanninger packing in the groove, says (page 115 Tr.):

"It is *wedged* up in there and the connection of the wedge is frictional."

The witness McDougall confirms this (page 222, Tr.).

Let the Court take in hand Exhibit 81, a sectioned

model of the accused device less only the locking means. Endeavor to push or wedge the sectioned packing as tightly as may be into the annular groove. Hold the exhibit in the hand with the sectioned packing upward, and it will, of course, drop of its own weight. If the small section be used, it will fall out. If the larger section be used, it will collapse until its bulk holds it. Obviously, it is its shape and size which causes its retention. A similar section of the packing, Exhibits 70 or 49, on the other hand, "wedged into the groove", as Mr. Vale says, will not fall out or collapse. The wedging action and the frictional retention serve to prevent it. A simple demonstration, but convincing of the difference in the two instrumentalities. The appellants have not merely changed the form of the packing element, but they have entirely departed from the principle of operation of the original Lanninger device so far as the operation of the packing is concerned. They depend upon bulk and shape instead of wedging action or frictional retention or clamping means in holding the packing within the annular groove; and as pointed out in appellants' brief they depend in the mode of operation of the packing in the accused devices upon hydraulic pressure upon *both* lips thereof, whereas, the Lanninger gasket or packing depends upon mechanical wedging or clamping action to seal the flange and effect retention of the gasket and upon hydraulic pressure for sealing on the free end *only*. Very obviously, too, the packing in the accused devices, because of its shape, can be neither clamped nor wedged so that neither of Lanninger's methods of retaining it in the groove is possible of application.



“To constitute identity of invention, and, therefore, infringement, not only must the result attained be the same, but in case the means used for its attainment is a combination of known elements, the elements combined in both cases must be the same”. *Electric Signal v. Hall Co.*, 114 U.S. 87, 96, 29 L. Ed. 96.

“If the device of the respondents shows a substantially different mode of operation, even though the result of the operation of the machine remains the same, infringement is avoided.” *Cimiotti Unhairing Co. v. American Fur Refining Co.*, 198 U. S. 399, 414, 49 L. Ed. 1100.

## **DEFENDANTS' CLAIM THAT THEIR DEVICES ARE MADE UNDER PIERCE PATENT**

**No. 1,945,293**

Here appellees claim that because the Pierce patent does not claim a flexible joint, no flexibility was intended. It is sufficient to say that, as pointed out by the appellees in their brief (page 54) the patentee was entitled to his invention in all of its forms, which certainly included the joint made loosely as well as tightly. So far, appellees' contention is at once disposed of; but as to the second matter raised under this heading, no claim is made contrary to the well settled principle of law, that a later patent does not authorize the later patentee to infringe the claims of an earlier patent.

## **MATTERS NOT DISCUSSED**

Several other points, mentioned in the answering brief of the appellees, and not herein analyzed, are not discussed herein owing to the limitations of space.

## CLAIM LANGUAGE NOT IGNORED BY TRIAL COURT

Again, in appellees' brief on this subject, we have a play upon words. Lanninger defined his packing by both of its trade names, differentiated it from the "U" packing, and showed the necessary means, preferably by clamping, but also by the frictional or wedging method, of sealing his flange and retaining it in the groove of the coupling. Now it is sought, by reason of the very wide and general definition of a "flange" contained in the dictionary, to depart entirely from the characteristic packing expressly taught by Lanninger in his application to the patent office, the descriptions contained in his specifications, and the teachings of his patent drawings and the express language of his claims, and to make his claims extend to and include all forms of packing having in any sense a "rim" or so-called "flange". The use, in combination, of the precise structure known to the art as a "flange" packing or a "hat" packing, which was one of the salient features of the patentee's concept is to be forgotten, and the appellees are to be given a monopoly on that which the patentee did *not* conceive, invent, or claim, but from which he expressly distinguished. It is respectfully submitted that claim language, substantiated as it is in this case by both patent office record and specifications, may not be so ignored.

Respectfully submitted,

J. S. MIDDLETON,

Attorney for Appellants.